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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/675,033	09/28/2000	Blair B.A. Birmingham	ATI-000090	7656

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EXAMINER
PATEL, HARESH N

ART UNIT	PAPER NUMBER
2154	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/06/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

	Application No.	Applicant(s)
Office Action Summary	09/675,033	BIRMINGHAM, BLAIR B.A.
	Examiner	Art Unit	
	Haresh Patel	2154	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 November 2006*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-46* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-46* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

1.   Claims 1-46 are subject to examination.

Double Patenting

2.   The claims 1-46 are provisionally rejected on the ground of non-statutory double

patenting over claims 1-64 of copending Application Number 10/869,165, please office action

dated 3/24/2006. The applicant states, "Applicant traverses with the rejection, ..., Applicant

declines to file a terminal disclaimer at this time". However, the applicant has failed to provide

any arguments for the traversal. The double patenting rejection is maintained.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or
> any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and
> requirements of this title.

3.   Claims 1-46 are rejected under 35 U.S.C. 101 because the claimed invention is directed

to a non-statutory subject matter. The claims 7-9, 11-25, 44-46 are software per see that is not

tangibly embodied on a computer <u>storage</u> medium such as <u>memory</u> and therefore lacks a

practical application because it alone cannot produce its intended outcome. Also, the claim 1

and its dependent claims perform executing but <u>do not produce concrete and tangible results</u>.

The claim 7 and its dependent claims contain operating systems "<u>to be</u>" executed, not executed,

which is <u>not stored on the memory</u>, and do not produce concrete and tangible results. The claim

18 and its dependent claims <u>do not produce concrete and tangible results</u>. The claim 26 and its

dependent claims perform executing <u>but do not produce concrete and tangible results</u>. Note: The

<u>execution by itself does not produce concrete and tangible results</u>. It's not until <u>the result of the</u>

<u>execution</u> is made available that it becomes a tangible result, which enables <u>any usefulness of</u>

<u>having done the execution to be realized</u>.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4.   Claims 18-25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with

the written description requirement. The claim(s) contains subject matter, which was not

described in the specification of this application under examination in such a way as to

reasonably convey to one skilled in the relevant art to use and/or make the invention.

The specification of this application under examination does not contain what "computer

readable medium" is.

5.   Claims 1-46 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with

the enablement requirement. The claim(s) contains subject matter, which was not described in

the specification of this application under examination in such a way as to enable one skilled in

the art to which it pertains, or with which it is most nearly connected, to make and/or use the

invention.

Claim 1 and its dependent claims are rejected under 35 U.S.C. 112, first paragraph, as

based on a disclosure which is not enabling. <u>Storages</u> such as memory for the plurality of

operating systems and the providing mechanism are critical or essential to the practice of the

invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*,

527 F.2d 1229, 188 USPQ 356 (CCPA 1976). The claim 1 contain "providing a plurality of

operating systems on a single information handling device", however, without storages such as

memory, the device cannot have the operating systems. There is no support on (providing

mechanism) who and how the providing of the operating systems is done. Also, it is not possible

to have the operating systems provided on a single information handling device, as providing to

the storages devices can be done, but not providing on as claimed. Similar applies to claims 18

and its dependent claims. Similar applies to claims 26 and its dependent claims. Similar applies

to claims 7 and its dependent claims.

Claim 1 contain "executing the appliance operating system", and "executing the general

operating system", together in the claim, which is contrary to the claim 8, which clearly states,

"bios is to control which of said plurality of operating systems is executed", meaning only one

operating system is executed. Also, it is not apparent how the claim 1 can have two operating

systems executed and active at the same time. Also, it is not possible to have another operating

system executed when the first operating system is still executed and active. Similar applies to

claims 18 and its dependent claims. Similar applies to claims 26 and its dependent claims.

Claim 1 and its dependent claims are rejected under 35 U.S.C. 112, first paragraph, as

based on a disclosure which is not enabling. Device drivers for controlling the appliances is

critical or essential to the practice of the invention, but not included in the claim(s) is not enabled

by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). The claim 1

contain "the appliance operating system to control a subset of the one or more appliances",

however, without having device drivers specific to the appliances the appliance operating system

cannot control the appliances (hardware). Also, it is not possible to have the appliance operating

system to directly communicate with the appliance (hardware) itself (through the network etc.,

see claims 11-16), as there is no interface/interfacing between the appliance operating system

and the appliances in the claimed subject matter of the claim 1. Similar applies to claims 18 and

its dependent claims. Similar applies to claims 26 and its dependent claims. Similar applies to

claims 7 and its dependent claims.

Claim 18 and its dependent claims are rejected under 35 U.S.C. 112, first paragraph, as

based on a disclosure which is not enabling. Claim 18 contain "appliance operating system on a

general purpose information handling system". It is not possible to have a general purpose

system (as in the claim 18) because the appliance operating system is specific to the appliance

and not for general purpose as claimed. Hence, general purpose system and the appliance

(specific) operating system cannot exist together. Also, it is not apparent how operating system

can be implemented on a system. One of ordinary skilled in the art very well knows that

software is implemented in a system. In fact, the claims 11, 12, 31, 37, etc., clearly mention that

the appliances are coupled to the device and the appliances being across a network and the

appliances being media handling systems (multiple), television, DVD player, etc. Even "general

purpose information" is not possible because each appliance contain its respective (specific)

information, hence multiple distinct information, rather general purpose as claimed.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the
> subject matter, which the applicant regards as his invention.

6.   Claims 1-46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for

failing to particularly point out and distinctly claim the subject matter which applicant regards as

the invention.

Claims 1 and its dependent claims recite the limitations, "single information handling

device". These limitations are indefinite for failing to particularly point out and distinctly claim

the subject matter in the claim as per MPEP rules and guidelines, MPEP 706.03(d). It is not

apparent how "single information handling device having one or more appliances" is possible, as

it one hand states single device and on other hand has multiple appliances, which is contrary to

single. In fact, the claims 11, 12, 31, 37, etc., clearly mention that the appliances are coupled to

the device and the appliances being across a network and the appliances being media handling

systems (multiple), television, DVD player, etc. Even "single information" is not possible

because each appliance contain its respective (specific) information, hence multiple information,

rather single information as claimed. Similar applies to claims 26 and its dependent claims.

Claims 1 and its dependent claims recite the limitations, "an appliance operating system

dedicated to control the information handling device to operate a subset of the one or more

appliances". These limitations are indefinite for failing to particularly point out and distinctly

claim the subject matter in the claim as per MPEP rules and guidelines, MPEP 706.03(d). It is

not apparent how the appliance operating system is dedicated; when the same appliance is used

for multiple functions, 1) to control the information handling device 2) operate multiple

appliances (a subset of the one or more appliances). In fact, the appliance operating system also

controls the information handling device similar to the general operating system. Similar applies

to claims 18 and its dependent claims. Similar applies to claims 26 and its dependent claims.

Similar applies to claims 7 and its dependent claims.

The term "general operating system" in claims 1 and dependent claims is a relative term,

which renders the claim indefinite. It is not apparent what is considered as "general" as the

specification of this application under prosecution clearly states, "while a general operating

system would be limited to controlling the built in CD player", which in fact is similar to

the appliance operating system because the CD player is an appliance too. One of ordinary

skilled in the art at the time of invention very clearly knows that each operating system,

including an appliance operating system also perform tasks that the general operating system

performs as claimed in the claim. Similar applies to claims 18 and its dependent claims. Similar

applies to claims 26 and its dependent claims. Similar applies to claims 7 and its dependent

claims.

The term "general information handling tasks" in claims 1 and dependent claims is a

relative term, which renders the claim indefinite. It is not apparent what is considered as

"general information handling tasks" as the specification of this application under prosecution

clearly states, "while a general operating system would be limited to controlling the built

in CD player", which in fact is similar to the tasks handled by the appliance operating system

because the CD player is an appliance too. Also it is not apparent that the general information

and /or tasks are for the general operating system itself or multiple operating systems. One of

ordinary skilled in the art at the time of invention very clearly knows that each operating system,

including an appliance operating system also perform tasks that the general operating system

performs as claimed in the claim. Similar applies to claims 18 and its dependent claims. Similar

applies to claims 26 and its dependent claims. Similar applies to claims 7 and its dependent

claims.

Claims 1 and its dependent claims recite the limitations, "the appliance operating system

is <u>independent of</u> the general operating system". These limitations are indefinite for failing to

particularly point out and distinctly claim the subject matter in the claim as per MPEP rules and

guidelines, MPEP 706.03(d). It is not apparent how the appliance operating system is

<u>independent</u> when the claims 3, 42-46, etc., clearly show that the appliance operating system and

the general operating system <u>depend</u> on each other for switching, etc. Similar applies to claims

18 and its dependent claims. Similar applies to claims 7 and its dependent claims.

Claims 4 recite the limitations, "executing ... operating systems concurrently" (along

with general operating system performing general information handling tasks). These limitations

are indefinite for failing to particularly point out and distinctly claim the subject matter in the

claim as per MPEP rules and guidelines, MPEP 706.03(d). It is not apparent how the general

operating system can perform general information tasks when the other appliance operating

system is executing (during the switching period) as one of ordinary skilled in the art at the time

of the invention very well knows that the general operating is waiting to be executed in the

concurrent processing (during the switching period). When the appliance operating system(s)

have their turn the general operating system <u>cannot do anything</u> and the general operating system

cannot perform any general tasks that are general and needed for the device <u>when the appliance</u>

operating system(s) <u>have their turn</u>. Similar applies to claim 22. Similar applies to claims 26 and

its dependent claims.

Claim 3 recites the limitations, "<u>the</u> execution". These limitations are indefinite for failing to particularly point out and distinctly claim the subject matter in the claim as per MPEP rules and guidelines, MPEP 706.03(d). It is not apparent which executing it is referred to.

Claims 30, 33, 36 recite the limitations, "<u>the</u> memory device". There is insufficient antecedent basis for this limitation in the claim (Please see MPEP 706.03(d)).

Claim 18 recites the limitations, "instructions to <u>implement</u> an appliance operating system <u>on</u> a general purpose information handling system". These limitations are indefinite for failing to particularly point out and distinctly claim the subject matter in the claim as per MPEP rules and guidelines, MPEP 706.03(d). In fact, the appliance operating system is not implemented but it is <u>already present</u> on a memory, etc. (see claims 5, etc.).

Claims 26 and its dependent claims recite the limitations, "appliance operating system <u>on</u> a singe information handling system", "general operating system <u>on</u> the singe information handling system". These limitations are indefinite for failing to particularly point out and distinctly claim the subject matter in the claim as per MPEP rules and guidelines, MPEP 706.03(d). The operating systems <u>on</u> a system cannot exist.

Note: Examiner has made an earnest effort to locate the limitations from the claims that are indefinite for failing to particularly point out and distinctly claim the subject matter. The applicant is requested to fix similar limitations, which the examiner might have overlooked, from the claims including other groups of claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Haresh Patel whose telephone number is (571) 272-3973. The examiner can normally be reached on Monday, Tuesday, Thursday and Friday from 10:00 am to 8:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (571) 272-3964. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Haresh Patel

Haresh Patel

December 1, 2006